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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,145	08/06/2001	Kenneth P. Carroll	SOLIS-002B1	9150

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STETINA BRUNDA GARRED & BRUCKER  
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EXAMINER


ROSEN, NICHOLAS D

ART UNIT PAPER NUMBER

3625

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/923,145	<b>Applicant(s)</b> CARROLL ET AL.	
	<b>Examiner</b> Nicholas D. Rosen	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/16/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/16/2001</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-21 have been examined.

#### ***Note Regarding Inventorship and Priority***

The instant application is a continuation-in-part of application 09/465,343, which is a continuation-in-part of application 09/356,963. However, the instant application has no inventors in common with these two applications, and is therefore not entitled to their filing dates. See Rule 1.78, and MPEP 201.08.

#### ***Claim Objections***

Claims 1-6 are objected to because of the following informalities: The preamble of claim 1 refers to "the improvement comprising:", but "the improvement" lacks antecedent basis, and there is no actual statement that claim 1 is a method claim. Claim 1 should recite, "a method comprising:". Appropriate correction is required.

Claim 6 is objected to because of the following informalities: Claim 6 has a step (f), but so does claim 2. It would be preferable to rename one of these steps to avoid ambiguity. Appropriate correction is required.

Claims 7-9 are objected to because of the following informalities: "end-user" is hyphenated in the third line of claim 7, but "end user" is not hyphenated in the eleventh and twelfth lines, or the twenty-second line of the claim. Consistency is preferable. Appropriate correction is required.

Claim 9 is objected to because of the following informalities: Claim 9 has a step (g), but so does claim 8. It would be preferable to rename one of these steps to avoid ambiguity. Appropriate correction is required.

Claims 10-12 are objected to because of the following informalities: In the sixteenth line of claim 10 (end of clause (c)), "the end user" lacks antecedent basis. (Also, "the end user" occurs at the end of claim 11.) Appropriate correction is required.

Claim 12 is objected to because of the following informalities: Claim 12 has a step (f), but so does claim 11. It would be preferable to rename one of these steps to avoid ambiguity. Appropriate correction is required.

Claims 13-15 are objected to because of the following informalities: "end-user" is hyphenated in the last line of claim 13, but "end user" is not hyphenated in the third line. Appropriate correction is required.

Claim 15 is objected to because of the following informalities: Claim 15 has a step (g), but so does claim 14. It would be preferable to rename one of these steps to avoid ambiguity. Appropriate correction is required.

Claim 21 is objected to because of the following informalities: Claim 21 has a step (g), but so does claim 17. It would be preferable to rename one of these steps to avoid ambiguity. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-6**

Claims 1, 2, 3, 4, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganesan et al. (U.S. Patent Application Publication 2002/0087461) and in view of the anonymous article "Fidelity Forges a Link Between Mutual Funds and Credit Cards," hereinafter "Fidelity Forges a Link," and official notice. As per claim 1, Ganesan discloses: (a) creating, through the use of a computer, an electronic gift certificate for a prescribed gift amount (paragraphs 40-49 and 197-199; Figures 18A, 18B, 19A, 19B, and 19C); (b) electronically transmitting, through the use of a computer, the gift certificate to an end user (paragraphs 40-49 and 197-199; Figures 18A, 18B, 19A, 19B, and 19C); and (c) redeeming the gift certificate for the gift amount (paragraphs 204-206 and 208-210). Ganesan does not disclose (d) electronically transferring the gift amount for the redeemed gift certificate into an investment account;

and (e) transferring the gift amount from the investment account into an investment product. However, "Fidelity Forges a Link" teaches depositing funds into an investment account, and transferring funds from the investment account into an investment product (entire article, especially second paragraph, beginning, "The Fidelity Investor Card").

"Fidelity Forges a Link" does not expressly disclose that the funds are gift amounts, or that they are transferred electronically, but official notice is taken that it is well known to conduct financial transactions by electronic transfer, and that it is well known to save or invest money given as gifts. Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to transfer the gift amount into the investment account, for the obvious advantage of helping to save for retirement, one's children's education, or other purposes; and to transfer the gift amount electronically, for the obvious advantage of not having to travel to a financial institution in person, and for the obvious advantage of not having to employ a scrivener to write out records of the financial transfer by hand.

As per claim 2, Ganesan does not disclose (f) completing at least one purchase transaction with at least one pre-authorized retailer for a prescribed purchase price, but "Fidelity Forges a Link" teaches a rebate on purchases (made using a credit card), which inherently implies completing at least one purchase transaction with at least one retailer, and official notice is taken that it is well known for credit card retailers to be pre-authorized (to process credit card transactions). "Fidelity Forges a Link" likewise teaches: (g) transferring a rebate sum corresponding to a prescribed percentage of the purchase price into the investment account; and later (h) transferring the rebate sum

from the investment account into the investment product (entire article, especially second paragraph, beginning, "The Fidelity Investor Card"). "Fidelity Forges a Link" does not expressly disclose that the rebate sums are transferred electronically, but official notice is taken that it is well known to conduct financial transactions by electronic transfer. Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to transfer the rebate sum into the investment account, and thence into the investment product, for the stated advantage of helping people save for such purposes as retirement or their children's educations; and to transfer the rebate sum electronically, for the obvious advantage of not having to travel to a financial institution in person, and for the obvious advantage of not having to employ a scrivener to write out records of the financial transfer by hand.

As per claim 3, neither Ganesan nor "Fidelity Forges a Link" expressly discloses completing multiple purchase transactions on an intermittent basis, but official notice is taken that it is well known to complete multiple purchase transactions on an intermittent basis. Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention for step (f) to comprise completing multiple purchase transactions on an intermittent basis, for the obvious advantage to the purchasers of making purchases as they found themselves in want of various goods and services, and able to afford them.

As per claim 4, neither Ganesan nor "Fidelity Forges a Link" discloses that the retailer is a global computer network retailer, or that step (f) is accomplished through the use of a computer, but official notice is taken that it is well known for retailers to be

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global computer network retailers, and for purchase transactions to be accomplished through the use of a computer (see, for example, Dias, U.S. Patent 6,170,017, column 1, lines 13-18; and Laing, "Cybermall Rats"). Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention for the retailer to be a global computer network retailer and for step (f) to be accomplished through the use of a computer, for the obvious advantage of letting people buy products offered through the global computer network, which in some cases would be unavailable (or at least difficult to find) in local shops.

As per claim 5, "Fidelity Forges a Link" discloses that step (h) (transferring the rebate sum from the investment account into the investment product) is completed subsequent to a total of the sums deposited into the investment account under step (g) reaching a minimum level (second and fifth paragraphs). Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention for step (h) to be completed subsequent to a total of the rebate sums deposited into the investment account under step (g) reaching a minimum level, for the obvious advantages of avoiding the expenses of administering an investment product with a trivial amount of money from a particular customer in it, and giving customers an incentive to make more purchases, with consequent fees, so as to accumulate a sufficient total of the rebate sums to qualify for an investment product.

As per claim 6, Ganesan discloses: (f) cancelling the gift certificate if the redemption of the gift certificate under step (c) is not completed within a prescribed period of time (paragraph 211).



**Claims 7-9**

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (WO 98/38562) in view of Ganesan et al. (U.S. Patent Application Publication 2002/0087461), the anonymous article "Fidelity Forges a Link Between Mutual Funds and Credit Cards," hereinafter "Fidelity Forges a Link," and official notice. As per claim 7, Ferguson discloses an investment method, comprising the steps of: (a) establishing an investment account associated with an end-user with an institution having defined relationships with at least one retailer and an investment product provider wherein the retailer agrees to electronically transfer a rebate sum corresponding to a completed purchase transaction to the institution for deposit into the investment account (page 6, line 22, through page 9, line 5), and the investment product provider agrees to invest any sums deposited into the investment account into an investment product pre-selected by the end user and structured to generate a return at an estimated annual rate having a net value corresponding to a total of any sums deposited therein and the return generated by the investment product in relation thereto (page 7, line 29, through page 8, line 16). Ferguson is not quite explicit about the investment product provider agreeing to invest any sums deposited into the investment account into an investment product pre-selected by the end user, but there would be little point in having the investment product, "such as a mutual fund or an Individual Retirement Account," without arrangements for the investment product provider actually to deposit funds therein. Also, insofar as Ferguson is not fully explicit, official notice is taken that accounts such as mutual funds and IRA's are

structured to generate a return at an estimated annual rate having a net value corresponding to a total of any sums deposited therein and the return generated by the investment product in relation thereto.

Ferguson does not disclose steps (b), (c), and (d), but Ganesan teaches: (b) creating, through the use of a computer, an electronic gift certificate for a prescribed gift amount (paragraphs 40-49 and 197-199; Figures 18A, 18B, 19A, 19B, and 19C); (c) electronically transmitting, through the use of a computer, the gift certificate to an end user (paragraphs 40-49 and 197-199; Figures 18A, 18B, 19A, 19B, and 19C); and (d) redeeming the gift certificate for the gift amount (paragraphs 204-206 and 208-210). Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to create, transmit, and redeem electronic gift certificates, for the stated advantage of providing funds for the recipient to use however he may desire, and the obvious advantage of enabling the sender of a gift certificate to conveniently contribute to someone whom he wishes to aid.

Ganesan does not disclose (e) increasing the net value of the investment account by electronically transferring the gift amount for the redeemed gift certificate into an investment account; and (f) transferring the gift amount from the investment account into an investment product, although Ganesan does disclose that the recipient can use the gift funds in any manner the recipient desires (paragraph 197). However, "Fidelity Forges a Link" teaches depositing funds (in addition to rebates) into an investment account, and transferring funds from the investment account into an investment product (entire article, especially second paragraph, beginning, "The Fidelity

Investor Card”). “Fidelity Forges a Link” does not expressly disclose that the funds are gift amounts, or that they are transferred electronically, but official notice is taken that it is well known to conduct financial transactions by electronic transfer, and that it is well known to save or invest money given as gifts. Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant’s invention to transfer the gift amount into the investment account and thence into the investment product, for the obvious advantage of helping to save for retirement, one’s children’s education, or other purposes; and to transfer the gift amount electronically, for the obvious advantage of not having to travel to a financial institution in person, and for the obvious advantage of not having to employ a scrivener to write out records or the financial transfers by hand.

As per claim 9, Ganesan teaches: (g) cancelling the gift certificate if the redemption of the gift certificate under step (d) is not completed within a prescribed period of time (paragraph 211). Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant’s invention to cancel the gift certificate if the redemption of the gift certificate under step (d) is not completed within a prescribed period of time, for the obvious advantage of avoiding keeping a gift certificate in financial limbo, with the recipient not enjoying it, and the sender uncertain of when or whether it would be charged against his account.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (WO 98/38562), Ganesan et al. (U.S. Patent Application Publication 2002/0087461), “Fidelity Forges a Link,” and official notice as applied to claim 7 above,

and further in view of Strachman ("Victoria Bank Offers its Trust Clients a Sweep Deal"). Ferguson discloses: (g) completing, through the use of a computer, multiple purchase transactions with at least one retailer (page 10, line 9, through page 11, line 14; page 17, line 30, through page 18, line 1); and (h) increasing the net value of the investment account by electronically transferring rebate sums generated under step (g) thereinto (page 15, lines 12-21). Ferguson does not expressly disclose that the purchase transactions are completed on an intermittent basis, but official notice is taken that it is well known to complete multiple purchase transactions on an intermittent basis. Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention for step (g) to comprise completing multiple purchase transactions on an intermittent basis, for the obvious advantage to the purchasers of making purchases as they found themselves in want of various goods and services, and able to afford them.

Ferguson discloses investment products (page 7, line 29, through page 8, line 16), but does not disclose (i) periodically transferring the rebate sums from the investment account into the investment product when a value of the investment account achieves a pre-selected threshold, but "Fidelity Forges a Link" teaches transferring rebate sums from the investment account into the investment product when a value of the investment account achieves a pre-selected threshold, and Strachman teaches periodically transferring sums from an account into a pre-selected investment product when a value of the account achieves a pre-selected threshold(see especially the eighth and subsequent paragraphs, beginning "Every morning"). Hence, it would have been

obvious to one of ordinary skill in the art of finance at the time of applicant's invention to periodically transfer sums from the investment account into the investment product when a value of the investment account achieves a pre-selected threshold, for the obvious advantage of achieving a higher expected return on sums in excess of the threshold.

### **Claims 10-12**

Claims 10, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (WO 98/38562) in view of Ganesan et al. (U.S. Patent Application Publication 2002/0087461), the anonymous article "Fidelity Forges a Link Between Mutual Funds and Credit Cards," hereinafter "Fidelity Forges a Link," and official notice. As per claim 10, Ferguson discloses an investment method, comprising the steps of: (a) establishing an investment account associated with an end-user with an institution having defined relationships with at least one retailer and an investment product provider wherein the retailer agrees to provide a rebate sum corresponding to a completed purchase transaction to the institution for deposit into the investment account (page 6, line 22, through page 9, line 5), the investment account being structured to generate a return at an estimated annual rate having a net value corresponding to a total of any sums deposited therein and the return generated by the investment product in relation thereto (page 7, line 29, through page 8, line 16). Also, insofar as Ferguson is not fully explicit, official notice is taken that accounts such as mutual funds and IRA's are structured to generate a return at an estimated annual rate having a net

value corresponding to a total of any sums deposited thereinto and the return generated by the investment product in relation thereto.

Ferguson does not disclose steps (b), (c), and (d), but Ganesan teaches: (b) creating, through the use of a computer, an electronic gift certificate for a prescribed gift amount (paragraphs 40-49 and 197-199; Figures 18A, 18B, 19A, 19B, and 19C); (c) electronically transmitting, through the use of a computer, the gift certificate to an end user (paragraphs 40-49 and 197-199; Figures 18A, 18B, 19A, 19B, and 19C); and (d) redeeming the gift certificate for the gift amount (paragraphs 204-206 and 208-210). Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to create, transmit, and redeem electronic gift certificates, for the stated advantage of providing funds for the recipient to use however he may desire, and the obvious advantage of enabling the sender of a gift certificate to conveniently contribute to someone whom he wishes to aid.

Ganesan does not disclose (e) increasing the net value of the investment account by electronically transferring the gift amount for the redeemed gift certificate into an investment account; and (f) transferring the gift amount from the investment account into an investment product, although Ganesan does disclose that the recipient can use the gift funds in any manner the recipient desires (paragraph 197). However, "Fidelity Forges a Link" teaches depositing funds (in addition to rebates) into an investment account, and transferring funds from the investment account into an investment product (entire article, especially second paragraph, beginning, "The Fidelity Investor Card"). "Fidelity Forges a Link" does not expressly disclose that the funds are

gift amounts, or that they are transferred electronically, but official notice is taken that it is well known to conduct financial transactions by electronic transfer, and that it is well known to save or invest money given as gifts. Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to transfer the gift amount into the investment account and thence into the investment product, for the obvious advantage of helping to save for retirement, one's children's education, or other purposes; and to transfer the gift amount electronically, for the obvious advantage of not having to travel to a financial institution in person, and for the obvious advantage of not having to employ a scrivener to write out records or the financial transfers by hand.

As per claim 11, Ferguson discloses: (f) completing, through the use of a computer, at least one purchase transaction with the retailer (page 10, line 9, through page 11, line 14; page 17, line 30, through page 18, line 1); and (g) increasing the net value of the investment account by electronically transferring rebate sums generated under step (g) thereinto (page 15, lines 12-21). Ferguson does not expressly disclose that the purchase transactions are completed on an intermittent basis, but official notice is taken that it is well known to complete multiple purchase transactions on an intermittent basis. Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention for step (g) to comprise completing multiple purchase transactions on an intermittent basis, for the obvious advantage to the purchasers of making purchases as they found themselves in want of various goods and services, and able to afford them.

Ferguson discloses investment products (page 7, line 29, through page 8, line 16), but does not quite expressly disclose (h) transferring the rebate sum from the investment account into the investment product preselected by the end user, although this could be considered inherent, since the investment products would be pointless if sums were not transferred into them. However, "Fidelity Forges a Link" teaches transferring rebate sums from the investment account into an investment product (second and fifth paragraphs). Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to transfer rebate sums from the investment account into the investment product, for the obvious advantage of achieving a higher expected return on the rebate sums.

As per claim 12, Ganesan teaches: (f) cancelling the gift certificate if the redemption of the gift certificate under step (d) is not completed within a prescribed period of time (paragraph 211). Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to cancel the gift certificate if the redemption of the gift certificate under step (d) is not completed within a prescribed period of time, for the obvious advantage of avoiding keeping a gift certificate in financial limbo, with the recipient not enjoying it, and the sender uncertain of when or whether it would be charged against his account.

### **Claims 13-15**

Claims 13, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganesan et al. (U.S. Patent Application Publication 2002/0087461) and in view of the anonymous article "Fidelity Forges a Link Between Mutual Funds and



Credit Cards,” hereinafter “Fidelity Forges a Link,” and official notice. As per claim 13, Ganesan discloses: (b) creating, through the use of a computer, an electronic gift certificate for a prescribed gift amount (paragraphs 40-49 and 197-199; Figures 18A, 18B, 19A, 19B, and 19C); (c) electronically transmitting, through the use of a computer, the gift certificate to an end user (paragraphs 40-49 and 197-199; Figures 18A, 18B, 19A, 19B, and 19C); and (d) redeeming the gift certificate for the gift amount (paragraphs 204-206 and 208-210). Ganesan does not disclose (e) electronically transferring the gift amount for the redeemed gift certificate into an investment account; and (f) transferring the gift amount from the investment account into an investment product. However, “Fidelity Forges a Link” teaches depositing funds into an investment account, and transferring funds from the investment account into an investment product which can be pre-selected by an end-user (entire article, especially second paragraph, beginning, “The Fidelity Investor Card,” and fifth paragraph, beginning “When savings reach \$2,500”). The existence of the investment account makes establishing it (step (a)) inherent. “Fidelity Forges a Link” does not expressly disclose that the funds are gift amounts, or that they are transferred electronically, but official notice is taken that it is well known to conduct financial transactions by electronic transfer, and that it is well known to save or invest money given as gifts. Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant’s invention to transfer the gift amount into the investment account, for the obvious advantage of helping to save for retirement, one’s children’s education, or other purposes; and to transfer the gift amount electronically, for the obvious advantage of not having to travel to a financial

institution in person, and for the obvious advantage of not having to employ a scrivener to write out records of the financial transfer by hand.

As per claim 14, Ganesan does not disclose (g) completing at least one purchase transaction with at least one pre-authorized retailer for a prescribed purchase price, but "Fidelity Forges a Link" teaches a rebate on purchases (made using a credit card), which inherently implies completing at least one purchase transaction with at least one retailer, and official notice is taken that it is well known for credit card retailers to be pre-authorized (to process credit card transactions). "Fidelity Forges a Link" likewise teaches: (h) transferring a rebate sum corresponding to a prescribed percentage of the purchase price into the investment account; and later (i) transferring the rebate sum from the investment account into the investment product (entire article, especially second paragraph, beginning, "The Fidelity Investor Card"). "Fidelity Forges a Link" does not expressly disclose that the rebate sums are transferred electronically, but official notice is taken that it is well known to conduct financial transactions by electronic transfer. Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to transfer the rebate sum into the investment account, and thence into the investment product, for the stated advantage of helping people save for such purposes as retirement or their children's educations; and to transfer the rebate sum electronically, for the obvious advantage of not having to travel to a financial institution in person, and for the obvious advantage of not having to employ a scrivener to write out records of the financial transfer by hand.

As per claim 15, Ganesan discloses: (f) cancelling the gift certificate if the redemption of the gift certificate under step (c) is not completed within a prescribed period of time (paragraph 211).

### **Claims 16-21**

Claims 16, 17, 18, 19, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganesan et al. (U.S. Patent Application Publication 2002/0087461) and in view of the anonymous article "Fidelity Forges a Link Between Mutual Funds and Credit Cards," hereinafter "Fidelity Forges a Link," and official notice. As per claim 16, elements (a), (b), (d), (e), and (f) correspond to elements (a), (b), (c), (d), and (e) of claim 1, respectively, and are therefore rejected on the same grounds set forth above with regard to claim 1. Ganesan does not disclose (c) establishing, through the use of a computer, an investment account associated with the end user, but "Fidelity Forges a Link" teaches investment accounts which would inherently have to be established, and official notice is taken that it is well known to use computers to establish and administer investment accounts. Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to establish the investment account through the use of a computer, for the obvious advantages of not having to travel to a financial institution in person, and not having to employ a scrivener to write out records of the investment account by hand.

Claims 17-21 are closely parallel to claims 2-6, respectively, and rejected on the same grounds set forth above with respect to those claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dias et al. (U.S. Patent 6,170,017) disclose a method and system of coordinating actions among a group of servers and disclose e-commerce). Feidelson et al. (U.S. Patent 6,345,261) disclose a customer loyalty incentive program. Hardesty (U.S. Patent 6,592,030) discloses a financial transaction system with retirement saving benefit. Van Dusen (U.S. Patent 6,594,644) discloses an electronic gift certificate system. Nahmias (U.S. Patent Application Publication 2004/0073480) discloses a method of providing a credit card-driven tuition incentive award program. Sullivan (U.S. Patent Application Publication 2004/0193539) discloses a mutual fund card method and system.

The anonymous articles, "iCanBuy.com and Security First Network Bank Teach Teens and Kids That It Pays to Save," and, "Free Plain-Talk Guides for Choosing Financial Accounts Now on Web," and the article by Pizzani, "What Separates out the Great Businesses Is Great Management," give examples of gifts being saved and/or invested.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone number

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for the organization where this application or proceeding is assigned is 703-872-9306.

Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*

**NICHOLAS D. ROSEN  
PRIMARY EXAMINER**

November 22, 2004